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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re the Application of

Mark Henry SHIPTON

Group Art Unit: 1775

Application No.: 10/540,533

Examiner: M. LAVILLA

Filed: July 19, 2005

Docket No.: 124323

For: RARE EARTH-TRANSITION METAL ALLOY ARTICLES

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the July 13, 2007 Restriction Requirement, Applicant provisionally elects Group I, claims 1-5 and 9-11, with traverse.

Applicant respectfully asserts that the requirement is improper under the rules of practice in PCT National Stage Applications, because the appropriate unity of invention standards have not been properly applied by the Patent Office. In PCT National Stage Applications, the Examiner may issue a Restriction-type requirement if no unity of invention exists. However, the Examiner must state why there is no "single general inventive concept." See MPEP §1893.03(d). Therefore, a single application may include one invention, or more than one invention if the inventions are "linked as to form a single general inventive concept." Id. (emphasis added). If multiple inventions are included in this application, they are deemed to be linked if there exists a "technical relationship among the inventions that involves at least one common or corresponding special technical feature." Id.

The Office Action asserts that unity of invention does not exist, because Groups I-III "lack the same or corresponding special technical feature." Applicant respectfully disagrees. The common special technical feature is a rare earth transition metal alloy structure with a noble metal diffusion barrier. See example 3, section 10.23 of the PCT International Search and Preliminary Examination Guidelines.

It is also respectfully submitted that the subject matter of all of claims 1-15 is sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to the Applicant and duplicative examination by the Patent Office.

Thus, reconsideration and withdrawal of the Restriction Requirement are respectfully requested.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Andrew B. Freistein
Registration No. 52,917

JAO:ABF/lah

Date: July 30, 2007

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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